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09/844,921	04/26/2001	Alan R. Peterson	P1403USC2	3534
<div>7590 08/06/2008</div> <div>JAMES C. SCHELLER, JR. BLAKELY, SOKOLOFF, TAYLOR &amp; ZAFMAN LLP 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025</div>				
EXAMINER				
VO, TED T				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/844,921

**Applicant(s)**

PETERSON ET AL.

**Examiner**

TED T. VO

**Art Unit**

2191

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-21 and 23-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-21 and 23-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the claims filed on 04/24/2008.

Claims 40-57 are new. Claims 19-21, 23-57 remain pending in the application.

#### ***Response to Arguments***

2. Response to the argument to 35 USC 112 first and second paragraph: Applicants argued that the examiner alleged the term, "computer readable medium" include are wireless; and direct a figure 1 and 2 in their specification. Respectfully responsive to this argument: Indeed, the computer art has included air and wireless, signal carriers are computer readable medium, where this term at the time of this effective filing remains having no clear definition. Figures 1-2 as pointed out by applicants show only a low level storage of computers existed before 1993. Using "computer readable medium" in the claims thus is insufficient antecedent basis, but tends to cover later definition in which at the time of this effective filing never thinking. On the other hand, Applicants also admitted at the time of their filing response, "computer readable medium" is common knowledge include such types of media addressed by the Examiner. If applicants traversed the rejections, they are contradicted to themselves from their admission.

Response to the argument to 35 USC 101: It should be noted that using a medium that is not defined in the specification means that the claims attempt covering everything including

energies that carry the instructions to the computer. Wireless media and signal carrier media are the computer-readable media. Such forms of media are non-statutory under 35 USC 101.

Response to the arguments with respect to the rejections under 35 102(b), being anticipated by Hanakawa: Applicants' argument fails to point out or address the patentability under the requirement of 37 CFR 1.111(b) and (c). Claims 23, 28-31, merely recite a common act known as playback in which it is been performed from a audio device or a sequence of movie frames. The argument fails to address any patentability in the claims. Hamakawa discloses, *displaying a starting state of multimedia content* (See Figure 9); *determining automatically, by the computer, which recorded actions satisfy a specified arbitrary criteria* (See p. 279, left col., last full paragraph, "On each playback task method invocation, the context object checks current real time by the gettimeofday system call and decides which frame in the video should be displayed); and *playing back a sequence of only those determined recorded actions in chronological order on an output device* (See Fig 12 that is playing back a sequence based on the context object check as described). Applicants' argument fails to consider the claimed language "*specified criteria*" that appears only a black box, and could be interpreted, where playing back frames disclosed in Hanakawa are played back in a chronologically ordered sequence programmed from a selection from the user based on decision in which what frame should be selected for displaying in playback performance of Figure 12. Clearly, the claims are old and read on thus a selection for playing back.

Response to the arguments with respect to the rejections under 35 102(b), being anticipated by Hardman et al: Applicants' argument fails to point out or address the patentability

under the requirement of 37 CFR 1.111(b) and (c). Claims 19-21, 23-39, merely recite common knowledge that merely records a determined sequence of events.

The argument fails to address any patentability in the claims. Hardman discloses “*receiving one or more user events during the development of the software content*”. See Figure 3, Walking route/playing order of nodes. notes: events); discloses “*determining which events and sequences of events constitute actions*”. See p. 286, left column: walking route sequence, within hierarchy view, the author can select any object); discloses “*determining, by the computer, whether an explanation accompanies an action*” (see p. 286, left column, note names, explicit duration, comment. See right column, table of contents); and discloses “*recording the determined actions during the development of the software content; and recording the determined explanations such that a recorded explanation of a recorded action is associated with the recorded action*” (See sec. 4.3). Applicants’ argument fails to consider the claimed language “*specified criteria*” that appears only a black box, and could be interpreted, where playing back frames disclosed in Hanakawa are played back in a chronologically ordered sequence programmed from a selection from the user based on decision in which what frame should be selected for displaying in playback performance of Figure 12. Clearly, the claims are old and read on thus a selection for playing back. The claims merely present the actions as a list of class and explanation. Applicant fails to address any patentability in the claims. It should be noted that a list of class and explanation does not present an inventive feature because it is just a common data structure, where this list of class with explanation reads on the hierarchy view discussed in p. 286, left column. Within the development, it represents the attributes. Thus, it allows the author to select object actions based one note names and comment, or color, etc.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims (23, 40, 48), (24, 41, 49), (25, 42, 50), (26-27, 51), (30-31, 53), (36-38, 46, 56) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not describe, “computer readable medium having stored thereon executable computer program instructions”, where the term computer readable medium used in the technology includes air, wireless transmission, and various types of energies that can store information. Applicants clearly admitted in an appeal brief that the medium alone would include various types. Other media such as very high density memories such as CD ROM, Flash memory, or extendable memory devices which were not described in the specification so that they can be carried out to perform the steps of the claims. The specification appears not covering or describing how its claims are related to “computer readable medium”. The “medium” used in

the claims is not consistent to the subject matter of the specification, but it appears covering **“new subject matter”**.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims (23, 40, 48), (24, 41, 49), (25, 42, 50), (26-27, 51), (30-31, 53), (36-38, 46, 56) recite the claimed subject matter, **“computer readable medium having stored thereon executable computer program instructions”**, that is insufficient antecedent basis in the specification. The type of medium is unknown. Thus, it is indefinite. The interpretation for this type of medium is to include air or wire less transmission, etc., because this type can store executable code for a computing device.

Claims (23, 40, 48), (24, 41, 49), (25, 42, 50), (28-29, 43, 52), (30-31, 53), (32-34, 45, 54), (36-38, 46, 56) recite *“satisfy a specified criteria”*, or *“meet a specified criteria”*, or *“meet a specified fixed criteria”*, *“based on preset criterion”*, respectively. The recitations are unclear; it does not know what a specified criteria is. What it makes to satisfy or to meet such a specified

criteria, or to be a specified fixed criteria is unclear. Using this claim language without any further associated functionality will have it as a black box. Thus, it fails to be as a limitation.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. The claims (23, 40, 48), (24, 41, 49), (25, 42, 50), (26-27, 51), (30-31, 53), (36-38, 46, 56) are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

Claims (23, 40, 48), (24, 41, 49), (25, 42, 50), (26-27, 51), (30-31, 53), (36-38, 46, 56) recite “computer readable medium”. According to Applicants’ admission, this medium includes non-statutory subject matter such as air, wireless transmission. The specification does not describe “medium”. According to the interpretation, it includes non-statutory subject matter. Also, in a response to the office action filed as an appeal brief, Applicants admitted that, nowadays, “computer readable medium” is common knowledge to an ordinary in the art and it includes wireless or signal carriers. The claims are rejected under 35 USC 101 because they direct to non-statutory claimed subject matter.



***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 23, 28-31, 40, 43-44, 48, 52-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamakawa et al., “Object Composition and Playback Models for Handling Multimedia Data”, Proceedings of the first ACM International Conference on Multimedia, Pages: 273-281, August 1993.

As per claim 23: Hamakawa discloses, *displaying a starting state of multimedia content* (See Figure 9);

*determining automatically, by the computer, which recorded actions satisfy a specified arbitrary criteria* (See p. 279, left col., last full paragraph, “On each playback task method invocation, the context object checks current real time by the gettimeofday system call and decides which frame in the video should be displayed (recorded actions satisfy a specified arbitrary criteria));

*and playing back a sequence of only those determined recorded actions in chronological order on an output device during a development of content* (See Fig 12 that is playing back a sequence based on the context object check as described).

As per Claims 28, 30: The claims recite the limitation that has the functionality corresponding to the Claim 23. See rationale addressed in Claim 23 above.

As per Claims 29, 31: Hamakawa discloses one action from the recorded action is accompanied by the recorded explanations, the recorded explanations along with recorded action. See Figure 7, p. 288.

As per claim 40: Hamakawa discloses *wherein the specified criteria is a user specified criteria* because the frames are selected in playing back based on decision for showing the performance of Figure 12.

As per claims 43, 44: See related rationale in claim 40 above.

As per claim 48: Hamakawa discloses *wherein recorded actions are actions that do not affect the content* because the selected frames do not affect any content.

As per claims 52-53: See related rationale in claim 48 above.

11. Claims 19-21, 23-39, 40-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Hardman et al., "Structure Multimedia Authoring", Proceedings of the first ACM International Conference on Multimedia, Pages: 283-289, August 1993.

As per Claim 19: Hardman discloses,

A method for recording and reviewing actions performed during development of software content created using a tool on a computer system having a processor and memory, said method comprising:

*receiving one or more user events during the development of the software content* (See Figure 3,

Walking route/playing order of nodes. notes: events);

*determining which events and sequences of events constitute actions* (see p. 286, left column:

walking route sequence, within hierarchy view, the author can select any object); *determining, by*

*the computer, whether an explanation accompanies an action* (see p. 286, left column, note

names, explicit duration, comment. See right column, table of contents); *recording the*

*determined actions during the development of the software content*; and *recording the*

*determined explanations such that a recorded explanation of a recorded action is associated with the recorded action.* (See sec. 4.3).

As per Claim 20: Hardman discloses,

*receiving a user request for playback of recorded actions* (Figure 3: places);

*accessing recorded actions and associated recorded explanations; and*

*playing back recorded actions and any associated recorded explanations.*

(See Figure 3, Playing order of nodes).

As per Claim 21: Hardman discloses,

*determining whether as explanation accompanies an action includes prompting a user for an explanation with respect to an action being recorded. (See sec. 4.3)*

As per claim 23: Hardman discloses,

*displaying a starting state of multimedia content (See Figure 1, p. 285, see Figure 2, the root; see Figure 7, from beginning, to end);*

*determining automatically, by the computer which recorded actions satisfy a specified arbitrary criteria (See p. 286, sec. 4.1.2; see Figures 3-4: places, for example, specifying a table of contents, for example, specifying Canal1, canal2, etc. , see sec. 4.3, allow to select which channels; see sec. 4.3, allow the author to play any part of the presentation);*

*and playing back a sequence of only those determined recorded actions in chronological order on an output device during a development of content (and See Figure 3, it is playing the order of placing nodes using walking routes; also see sec. 4.1.2).*

As per claim 24: Hardman discloses the claim. See rationale as addressed in the claim 19.

As per claim 25: Hardman discloses the claim. See Figure 1, and sec. 4; furthermore, see rationale as addressed in the claim 19.

As per claim 26: Hardman discloses, *A computer-readable medium having stored thereon executable computer program instructions, the executable computer program instructions*

*including an action class list and, when executed by a digital processing system, causing the system to perform a method for playback of actions from the action class list, wherein:*

*the action class list comprises a plurality of action class description fields (See Figure 3, playing order of nodes), each action class description field having a first field containing data which specifies a particular action class and a second field containing data which specifies a generic explanation of the action specified in the corresponding first field, wherein the action class list is used during playback of an action, during a development of content, to determine an explanation associated with the action class of the action and to accompany the played back action with the determined explanation (See Figure 7, e.g., the information in the boxes relates to a recording action Canal2, as selected from Walking route of Figure3.*

As per claim 27: Hardman discloses, *A computer-readable medium as defined in claim 26 wherein said second field identifies a software routine capable of producing an explanation based upon properties of a recorded action.* See Figure 7.

As per claim 28: Hardman discloses the claim. See related rationale addressed in Claim 23.

As per claim 29: Hardman discloses, *The method of claim 28, wherein: at least one action from said recorded actions is accompanied by an explanation and said playing back further comprises playing back any associated recorded explanations along with recorded actions.* See p. 288, sec. 4.3; see Fig. 7.

As per claim 30: Hardman discloses the claim. See related rationale addressed in Claim 23.

As per claim 31: Hardman discloses, *The computer-readable medium of claim 30, wherein: at least one action from said recorded actions is accompanied by an explanation and said playing*

*back further comprises playing back any associated recorded explanations along with recorded actions.* See p. 288, sec. 4.3, see Fig. 7.

As per claim 32: Hardman discloses the claim. See rationale addressed in Claim 19 above.

As per claim 33: Hardman discloses the claim. See rationale addressed in Claim 20 above.

As per claim 34: Hardman discloses, *The apparatus of claim 32, wherein: said playback is based on determining automatically which recorded actions satisfy a specified arbitrary criteria.* See Figures 2-3, placing of notes is arbitrarily selected by the author.

As per claim 35: Hardman discloses the claim. See rationale addressed in Claim 19 above.

As per claim 36: Hardman discloses the claim. See rationale addressed in Claim 19 above and furthermore see Figures 1-3, and sec. 4.

As per claim 37: Hardman discloses the claim. See rationale addressed in Claim 20.

As per claim 38: Hardman discloses, *The computer-readable medium of claim 36, wherein: said determining comprises determining which events and sequences of events constitute actions by applying one of a plurality of granularities, said one of a plurality of granularities being selected based on criteria, whereby said applied one of a plurality of granularities varies depending on the criteria.* See Figures 1-3.

As per claim 39: Hardman discloses, *An apparatus for recording and reviewing actions performed during development of content created using a tool on a computer system having a processor and memory, said apparatus comprising: a user interface means for receiving user events which occur during development of content; and a recorder module coupled to receive user events from said user interface means, said recorder module determining which events and*

*sequences of events constitute actions and recording those actions, said recorder module capable of recording an explanation for each individual action, said explanations being recorded in a manner which associates a recorded explanation of a recorded action with the recorded action.* See Figures 2-3, and 7.

As per claim 40: Hardman discloses *wherein the specified criteria is a user specified criteria* (See p. 286, sec. 4.1.2; see Figures 3-4: places, for example, specifying a table of contents, for example, specifying Canal1, canal2, etc. , see sec. 4.3, allow to select which channels; see sec. 4.3, allow the author to play any part of the presentation);

As per claims 41, 42, 43, 44, 45, 46: See related rationale in claim 40 above.

As per claim 47: Incorporated with the rejection of claim 19, Hardman discloses *wherein recorded actions are actions that do not affect the content* because the specifying actions such as in the table do not effect any content.

As per claim 48: Incorporated with the rejection of claim 23, Hardman discloses *wherein recorded actions are actions that do not affect the content* because the specifying actions such as in the table do not effect any content.

As per claims 49-57: See related rationale in claim 48 above.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be reached on 8:00AM to 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708.

The facsimile number for the organization where this application or proceeding is assigned is the Central Facsimile number 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of



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an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTV  
July 31, 2008

/Ted T. Vo/  
Primary Examiner, Art Unit 2191